

REMARKS

In the Office Action¹, the Examiner rejected claims 13-15, 17, and 18 under 35 U.S.C. §112, first paragraph; rejected claims 13, 15, 17, and 18 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,958,265 to Ogahara ("*Ogahara*"); rejected claims 13, 15, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Ogahara*, in view of U.S. Patent No. 3,904,506 to Carmichael et al. ("*Carmichael*"), in view of U.S. Patent No. 5,891,350 to Shan et al. ("*Shan*"), and further in view of U.S. Patent No. 6,022,418 to Iwabuchi ("*Iwabuchi*"); and rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Ogahara* in view of U.S. Patent No. 5,919,332 to Koshiishi et al. ("*Koshiishi*").

Applicants have amended claims 13, 15, 17, and 18. Claims 13-15, 17, and 18 remain pending.

Regarding the rejection of claims 13-15, 17, and 18 under 35 U.S.C. §112, first paragraph, Applicants do not agree with the Examiner's assertions. Nonetheless, in an effort to expedite prosecution, Applicants have amended claim 13 to remove "a whole area of a bottom of" and add --made of aluminum, and forming an Al₂O₃ film at a surface of the thermal conductivity adjusting member--. Applicants submit that these elements are disclosed in the Specification on page 24, line 23 - page 25, line 28, for example. Therefore, Applicants request that the Examiner withdraw the rejection of the claims 13-15, 17, and 18 under 35 U.S.C. §112, first paragraph.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully traverse the rejection of claims 13, 15, 17, and 18 under 35 U.S.C. § 102(e) as anticipated by *Ogahara*. In order to properly establish that *Ogahara* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 13 recites a plasma processing apparatus comprising:

a thermal conductivity adjusting member, for adjusting a thermal conductivity between the electrode and the electrically conductive ring body, provided between said electrode and said electrically conductive ring body, attached to said electrically conductive ring body, made of aluminum, and forming an Al₂O₃ film at a surface of the thermal conductivity adjusting member.

(emphasis added). *Ogahara* does not disclose each and every element of Applicants' claimed invention.

Ogahara discloses a characteristic correction ring 9 "situated so as to enclose the circumference of the held substrate 10" (col. 5, lines 13-14). Applicants submit that *Ogahara* is silent regarding the claimed Al₂O₃ film. Therefore, *Ogahara* does not teach or suggest the claimed combination of elements including a thermal conductivity adjusting member "made of aluminum, and forming an Al₂O₃ film at a surface of the thermal conductivity adjusting member," as recited in claim 13.

Ogahara fails to teach at least these elements. Accordingly, *Ogahara* cannot anticipate claim 13. Thus, claim 13 is allowable for these reasons, and claims 15, 17, and 18 are also allowable at least due to their depending from claim 13.

Regarding the rejection of claims 13, 15, 17, and 18 under 35 U.S.C. § 103, Applicants submit that *Carmichael, Shan, and Iwabuchi* fail to cure the deficiencies of *Ogahara* as stated above. The Examiner relies upon the combination of *Carmichael, Shan, and Iwabuchi* to allegedly disclose thermal adjusting with rings and bolts, torque on a screw to adjust thermal conductivity, and shielding bolt heads from plasma (Office Action at page 4). Even assuming that this is correct, Applicants submit that *Carmichael, Shan, and Iwabuchi* are silent regarding the claimed Al_2O_3 film. Therefore, *Carmichael, Shan, and Iwabuchi* do not teach or suggest the claimed combination of elements including a thermal conductivity adjusting member “made of aluminum, and forming an Al_2O_3 film at a surface of the thermal conductivity adjusting member,” as recited in claim 13.

Therefore, no *prima facie* case of obviousness has been established, and claims 13, 15, 17, and 18 are allowable over *Ogahara, Carmichael, Shan, and Iwabuchi*.

Although the Examiner cites *Koshiishi* in the rejection of dependent claim 14, Applicants respectfully assert that *Koshiishi* fails to cure the deficiencies of *Ogahara* discussed above.

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Customer No. 22,852
Application No. 10/675,966
Attorney Docket No. 07553.0019-01

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 7, 2007

By: /David W. Hill/
David W. Hill
Reg. No. 28,220